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Robert Bernstein

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EXAMINER

CARLSON, JEFFREY D

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/777,098
Filing Date: February 05, 2001
Appellant(s): BERNSTEIN, ROBERT

Jon Christensen
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/13/2008 appealing from the Office action mailed 10/17/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

20030018613	OYTAC	1-2003
6347304	TARICANI, JR	2-2002

US Provisional Patent Application 60/221774, filed 7/31/2000 by OYTAC - incorporated by reference into 20030018613 to OYTAC - and the provisional to 20030018613 to OYTAC.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 9-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 is directed to an apparatus that includes (among other elements) a database that contains customer information. When the apparatus claim (on 3/6/2007) previously recited "database...that contains customer information *provided by a plurality of independent vendors*", the examiner gave it a 112¶2 rejection stating that it was unclear in what way the source of such information (i.e. *provided by a plurality of independent vendors*) limited the database itself and therefore, the structure of the

apparatus claim. Examiner questioned (5/21/2007) whether applicant was intending to claim a method step of *how* the information was provided/acquired by the database. Applicant amended the claim on 8/6/2007 "database...that contains customer information *from a plurality of independent vendors*", but this change did not remove the questions about the claim scope. Describing where the information came from still leads to confusion as to whether applicant is intending to claim some structure (or method step?) associated with gathering the information before storage in the database. A database physically storing information is the same apparatus regardless of where the information came from or who provided the information for storage. A piggybank apparatus containing a quarter is the same structure regardless of whether the quarter was lent to the recipient, found on the street by the recipient, or was part of the recipient's change following a transaction. Claiming where the quarter came from in such an apparatus claim leads one to question whether there is an additional feature within the claim scope or not.

Claim 9 continues to present a similar distinctness problem for its language of "a customer profile *provided by a vendor*".

Claims 1-6, 8-14, 16-20, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oytac (US2003/0018613) in view of Taricani, Jr. (US6347304) or alternatively over Taricani, Jr. in view of Oytac.

Oytac is a published application which enjoys the earlier benefit of and incorporates by reference provisional application number 60/221774 (filed 7/31/00).

This Office Action shall refer to the disclosure of 60/221774 by page number rather than the 2003/0018613 document.

Regarding claims 1, 9, 17, Oytac teaches information providers (banks, credit card processors, etc.) that compile detailed user profiles concerning the user's purchasing histories. This is taken to provide a third party database. Information users (vendors) define desired profiles for users who are to receive targeted promotional materials. Customers who match the defined profiles are selected as the recipients of the defined promotional materials [pg 1 of 60/221774]. Oytac teaches that an interface is provided for a vendor to define the desired profile characteristics and the promotional materials to be delivered [pg 2, fig 1 of 60/221774]. The system of Oytac performs a matching of stored profiles and defined desired profiles and is taken to meet the comparator/searching limitations. Oytac's system then can automatically deliver the promotional materials. Oytac does not however explicitly state that the database system of consumer purchase information is one which also calculates taxes due on such purchases. Oytac describes the added value present in a system which stores digital "transaction data regarding consumer purchases". Oytac states that banks and credit card processors are two such system examples, however Oytac also states that further examples are contemplated (banks, credit card processors, "etc") [page 1 line 1]. Taricani, Jr. teaches a tax system wherein consumer transaction data is stored in a database that includes purchaser identity, dates, amounts, purchase item categories, etc. [col 7 lines 23-30]. The system of Taricani, Jr. calculates a tax due based on the consumer's purchasing history [col 7 lines 1-3]. Clearly one of ordinary skill would

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recognize that such a database of digital consumer purchasing data also has value for marketing purposes. It would have been obvious to have provided the features of Oytac with the system of Taricani, Jr. so that additional revenue could be generated from the valuable consumer data. Likewise, it would have been obvious that the marketing system of Oytac could be implemented with an entity that provided such a tax-related consumer purchasing database.

Regarding claims 2-4, 10-12, 18, 19, Oytac teaches that a POS system can provide trigger-driven promotions printed on a receipt [pg 4]. Oytac teaches that the promotions can include coupons [pg 2].

Regarding claims 5, 13, Oytac teaches a promotional delivery channel using email [pg 4].

Regarding claims 6, 14, 20, the broad limitation that the promotional materials include "indicia of authenticity" without any corresponding steps or feature to verify the authenticity of such indicia can be met by any indicia printed on the promotion of Oytac. The printed materials of Oytac are taken to inherently include at least some "indicia".

Regarding claims 8, 16, 22, Oytac teaches an example where promotions are based upon types of purchases [pg 5]. Oytac also teaches the use of product categories [pg 22]. Further, Taricani, Jr. teaches that the purchasing data can also include item categorization [col 7 line 28].

Claims 7, 15, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oytac in view of Taricani, Jr. and Katz (US20020077901) or alternatively over Taricani, Jr. in view of Oytac and Katz.

Page 10 of Katz's 60/256324 has been included to demonstrate support for the important feature to 12/19/2000.

Regarding claims 7, 15, 21, Oytac teaches targeting to users based upon location [pg 5], but not necessarily based upon purchase location. Katz teaches custom promotions offered to users that includes various user profile parameters including locations where purchases were made [¶ 40]. It would have been obvious to one of ordinary skill at the time of the invention to have targeted the consumers of Oytac/Taricani with such a purchase location parameter.

(10) Response to Argument

Applicant argues that Taricani, Jr. acts on the behalf of the revenue agency and is therefore limited by agency law and "US privacy law", yet applicant provides no specific legal citations. Nonetheless, the examiner is treating the claims and applying prior art with respect to technological achievements/aspects rather than any ethical, political or legal hurdles that may impede a proper obvious combination. Further, and as applicant is clearly aware, it is routine for entities to first get opt-in acceptance from users before their private or consumer information may be used for

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marketing/advertising purposes. Such would be an obvious aspect for one of ordinary skill and for the proposed combination and one which would avoid any privacy issues.

Examiner believes that one of ordinary skill would find it obvious to try to target the consumer profiles of Taricani, Jr. given the teachings of Oytac and in the alternative to provide the tax services of Taricani, Jr. with that of Oytac. The cited article "IRS may let tax preparers sell customer's information" provides evidence that the IRS allows tax preparers to target consumers according to their private information. In fact, the IRS is keen to expand that use of consumer information to enable any third party to use it for marketing purposes. One of ordinary skill would find it obvious to extract marketing value from the tax database of Taricani, Jr. by way of targeting advertising/marketing in the interest of generating revenue. Whether this is ethical/legal or not does not prevent one of ordinary skill from considering such acts or if needed, to change policies to permit it. If indeed penalties are in place for using such private information, those penalties inherently represent consideration of doing such an act, rendering the act obvious. And if penalties are in place for using such private information, one of ordinary skill might have found the penalties worthwhile to pay in order to practice what would have been obvious – to target the users in the tax database with advertising in order to generate revenue.

Applicant argues that Taricani, Jr. "is not a database of past purchases", yet admits Taricani, Jr. provides a "database of transactions". Clearly, a "database of transactions" describing transactions that have already occurred represents a database of past purchases. Whether the taxes have been paid or not is outside the current claim

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scope. "Why" the claimed database exists does not prevent the combination from reading on the current claims.

Applicant's argument that the Taricani, Jr. database is one having possible criminal evidence is an argument that does not appear pertinent to the rejection at hand.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

jdc
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